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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/503,770 02/14/00 PERRAULT J 041861-25301

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EXAMINER

HARRISON, R

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

03/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/503,770

Applicant(s)
Perrault et al

Examiner
Robert H. Harrison

Group Art Unit
1619



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-36 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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With the cancellation of claims 37-51, claims 1-36 are in the case and an action is as follows:

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. ✓

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

Please note if applicants' wish the "citation of prior art" in the preliminary amendment to be cited on the face of the patent, then applicants' should cite such in a PTO-1449.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

→ In claim 2, the subscripts for the C-C alkyl are not clearly rendered.

✓ In each of the independent claims, the expression, "... polymer of the formula..." is indefinite. The examiner suggests, "... polymer having the formula..."

✓ In claims 21, 22, 35, and 36 "said cationic quaternary amine poly acrylate polymer" lacks clear antecedent basis in claims 11, and 23.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 and 4-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 and 22-26 of U.S. Patent No. 5,800,685. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is no clear line of patentable demarcation between the respective sets of claims.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4,6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Jevne et al ('356).

Jevne et al. disclose a basic homopolymer of MAPTAH that may be used as a blend with an acidic homopolymer to form a hydrogel. Prior to blending the claimed polymer in the instant case is fully disclosed by Jevne et al. See column 5, lines 50-51 and example 2. Since the structures are the same, the property of antimicrobial activity is inherent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 11,12,14,16,20,21,22-26,28,30, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jevne et al.

Jevne et al. has been discussed above.

Jevne et al. disclose and claim wound dressings and hydrogel medical devices containing (comprising) the claimed polymers.

Jevne et al. do not explicitly mention the recited amounts of the polymer in the hydrogel as well as the structural feature of the device in claims 24-26.

It would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to select the claimed ranges and the device features of claims 24-26 since they appear to be well known routine wound dressing devices that would be immediately envisaged by the artisan having ordinary skill in the art absent evidence to the contrary. Optimum suitable ranges of the polymer in the dressing/device would involve mere routine experimentation.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shibahara et al ('307) Shibahara et al. disclose a polymer consisting of 100% of a polymerized monomer that

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fully satisfies all parameters of the instant polymer as claimed. See column 2, lines 23-41; column 3, lines 1-5 and claim 19. Since the structure is the same and the molecular weights are encompassed and/or no limits placed on MW, then antimicrobial activity would be inherent.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wood et al., ('576) merely cited as a cumulative reference teaching the claimed polymer.

Any inquiry concerning this communication should be directed to Robert Harrison at telephone number (703) -308-2422.

Harrison/LR

March 27, 2001

Robert H. Harrison
ROBERT H. HARRISON
PRIMARY EXAMINER
Group 1619